

Remarks

Upon entry of the forgoing amendments claims 1-29 are pending in the application. Claims 1-6 and 8 and 9. The amendment does not introduce any new subject matter within the meaning of 35 U.S.C. §132. Therefore, entry of the amendments is respectfully requested.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required restriction of claims 1-29 under 35 U.S.C. §§ 121 as follows:

- Group I: Claims 1-9, drawn to an in vitro method for inducing a conformational transition in recombinant proteins and/or variants thereof, classified in class 702, subclass 19.
- Group II: Claim 10, drawn to an oligomeric beta-sheet Intermediate structure produced via the method of above Group I, classified in class 530, subclass 350.
- Group III: Claim 11, drawn to an amyloidogenic aggregates produced from the above Group II intermediate, classified in class 530, subclass 350.
- Group IV: Claims 12-26, drawn to use of water soluble complexes of oligomeric beta-sheet intermediates or amyloidogenic aggregates for exploitation of aspects of the conversion, classified in class 702, subclass 19.
- Group V: Claim 27-29, drawn to compositions of water soluble complexes of oligomeric beta-sheet intermediates or amyloidogenic aggregates for diagnosis or treatment classified in class 435 and 514, subclass 4 and 2, respectively.

Additionally, the Examiner has required Applicants to elect one of the species of disease disclosed in claim 6.

PROVISIONAL ELECTION

Applicants provisionally elect the invention of Group I above, and the species Transmissible Spongiform Encephalopathy (TSE) of claim 6.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement.

First, MPEP § 803 specifies that restriction/election between two groups of claims is only proper when (1) one group of claims is independent **or** distinct from another group of claims and (2) a "serious burden" exists on the examiner in examining both groups of claims.

The Examiner can show a "serious burden" by establishing one of: the inventions are classified separately; the inventions have been classified together, but it can be shown that each subject has formed a separate subject for inventive effort (can cite patents or show a separate field of search); or the inventions require a separate field of search, that is, it is necessary to search for one subject in a place where no pertinent art for the other subject exists (MPEP § 808.02 (c)).

In the present application, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required between Groups I-V. See MPEP

§ 803. A complete and thorough search for the invention set forth in all of the alleged Groups would require searching the art areas appropriate to the other Groups. Since a search of each of the inventions of Groups I-V would be coextensive, it would not be a *serious* burden upon the Examiner to examine all of the claims in this application.

Further, at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Moreover, given the overlapping subject matter, examination of the claims in this application would not pose a serious burden, because the searches would be coextensive.

Additionally, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Furthermore, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for

the claims (which would be later prosecuted in divisional applications) are not refundable.

Finally, Applicants note that upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

CONCLUSION

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the requirement for claim restriction and election of species and examine all claims pending in this application.

If the Examiner has any questions or wishes to discuss this application, kindly telephone the undersigned at the below-listed number.

Respectfully submitted,

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